



**UNITED STATES DEPARTMENT OF COMMERCE**  
**Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

AD

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/347,069 07/02/99 KORMAN

B 141815-5

EXAMINER

FRECH, K

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 05/19/00

MMC2/0519

BRIAN M. BERLINER, ESQ.  
O MELVENY & MYERS LLP  
400 SOUTH HOPE STREET  
LOS ANGELES, CA 90071-2899

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/347,069

Applicant(s)  
Korman

Examiner  
Karl D. Frech

Group Art Unit  
2876

☒ Responsive to communication(s) filed on Mar 27, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-63 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☒ Claim(s) 1-33 and 48-53 is/are allowed.

☒ Claim(s) 34-47 and 54-63 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 2876

1. The amendment filed March 27, 2000 has been entered as paper number 8. Claims 1-53 have been amended and claims 54-63 have been added.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. Claim 54-57 are rejected under 35 U.S.C. 102(e) as being anticipated by Daly et al 5,878,141. Daly discloses in column 6 lines 56+ a transaction system where a purchaser terminal is networked to a centrally located transaction processing unit. These are connected via a network to a plurality of merchant/service provider servers. That is, Daly discloses that a transaction terminal is connected to a host which in turn is networked to a plurality of destination computers. It is inherent that there is an interface and appropriate communication protocols between the computers of the network. It is disclosed in column 7 that the merchant/service providers may be banking and non banking entities, including credit card companies.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2876

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 58-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Daly et al 5,878,141. Daly discloses the system as seen above. Daly also discloses input of proper identification into the purchaser computer in column 8. Columns 7 and 8 also disclose the method of use of this system as currently claimed. Daly does not specifically disclose the asynchronous communication. Asynchronous communications between networked computers is old and well known. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to asynchronously communicate between the host of Daly and the plurality of merchant/service provider computers. This would allow for more efficient communication between the computers and therefore more rapid transaction processing time.

6. Claims 33-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Daly et al 5,878,141 in view of known prior art. Daly discloses the invention as seen above, Daly does not specifically disclose the multimedia dispenser as claimed. Personal computers connected to an Internet host are old and well known. Also, downloading multimedia formatted files over the

Art Unit: 2876

Internet is old and well known. Also, it is old and well known to save these multimedia files onto a removable disk, such as a 3.5 floppy or a ZIP disk, i.e. multimedia dispensing. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to use a PC in the system of Daly. This would allow for home shopping and home banking.

7. Claims 1-33,48-53 are allowable over the prior art of record.

8. The following is a statement of reasons for the indication of allowable subject matter: The prior art of record fails to teach or fairly suggest a transaction terminal which in itself formats for and directly communicates with a plurality of service provider computers along with **all** the other limitations of the independent claims. As reasonably defined by the claims and the related description within the specification, for purposes of claims 1-33 there is no intermediate host computer. It is in the conventional host where the appropriate communication protocols and formats are conventionally set.

9. Applicant's arguments with respect to claims 34-47 have been considered but are moot in view of the new ground(s) of rejection.

10. As the rejection of claims 34-47 has changed due to no action on the part of the applicant, this action is **NOT MADE FINAL**. It is acknowledged that the amendments to claims 34-47 did not necessitate the new grounds of rejection.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karl Frech whose telephone number is (703) 305-3491. The examiner can normally be reached workdays from 8:30 AM to 3:30 PM.

Art Unit: 2876

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald T. Hajec, can be reached on (703) 308-4075. The fax phone number for this Group is (703) 308-7722.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [karl.frech@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any fax transmission which may be intended as non-official for consideration by the examiner for interviews or other purposes should be clearly marked "DRAFT" and/or "COURTESY COPY" along with a statement to "DELIVER DIRECTLY TO EXAMINER". Such an un-official fax transmission must not be signed as it **will not** be entered into the application.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703)308-0956.



Karl Frech

Primary Examiner, AU 2876

May 19, 2000